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Remarks

Claims 1- 31 are pending in this application. By this paper, Applicants have amended claims 3-5, 7-11, 13-14, 16, 20, 23, 25-27, 29 and 31, and have cancelled claims 18, 21, 22 and 30.

The present invention relates to a sliding visor and is the subject of reissue examination as discussed herein.

Reissue Applications

1. Applicants acknowledge the Examiner's reminder of the continuing obligation under 37 C.F.R. § 1.178(b) to timely apprise the Office of any prior or concurrent preceding in which Patent No. 6,010,174 is or was involved. Applicants also acknowledge the Examiner's reminder of the continuing obligation under 37 C.F.R. § 1.56 to timely apprise the office of any information which is material to patentability of the claims under consideration in this reissue application.

2. The reissue oath/declaration included in the Petition Under 37 C.F.R. § 1.47(a) filed on February 18, 2003 is to overcome the defective reissue oath/declaration previously filed. The reissue oath/declaration has been modified to overcome these informalities, and to describe the error of the issued patent with more specificity.

3. Accordingly, Applicants respectively assert that the newly filed reissue oath/declaration overcomes the Examiner's rejection of claims 1-31 under 35 U.S.C. § 251.

Claim Rejections Under 35 U.S.C. § 112

4,5. Claim 3 has been amended by this paper to address the Examiner's rejection by including a clear frame of reference for the spacial relationship of the walls relative to the visor body. Rather than using the terms "vertical" and "horizontal," the terms "parallel" and "perpendicular" have been added to clarify the spacial relationship.

Claim 4 has been amended to correct a typographical error.

Claim 7 has been amended to overcome vagueness and to particularly point out and distinctly claim the invention by clearly describing the claimed movement. Support for this change is provided by Figures 6 and 7 and the accompanying text at column 5, lines 25-40.

Claims 9 and 20 have been amended to claim the U-shaped lowermost portion of the guide, rather than claiming a U-shaped guide. This change clarifies the described structure, such that only a portion of the guide is U-shaped. Support for this change is provided by Figure 3.

In regards to claim 11, ridge 104 is defined in column 4, lines 35-36.

Claim 13 has been corrected by the amended claim language, such that "a portion" of the visor body, rather than the pivotal connection, contacts the pivotal attachment. Support for this change is provided in Figures 2, 6 and 7 and the accompanying text at column 5, lines 25-40.

Claims 14, 26 and 27 have been amended to include "a portion of" said visor body, as suggested by the Examiner, to overcome vagueness. Support for this change is provided in Figures 2, 6 and 7 and the accompanying text at column 5, lines 25-40.

Claim 16 has been amended to particularly point out and distinctly claim the relationship of the torque control position while maintaining positions of other elements. Specifically, the vague description of the relationship, “while maintaining a rotational position of said second pivotal attachment with respect to the rod related to a rotational position of said first pivotal attachment with respect to the rod”, has been removed and the following underlined language has been added to the claim element of the track:

“a longitudinally extending track interconnecting the opposing legs of the guide and the visor body in sliding engagement parallel to the longitudinal rod such that the torque control maintains a rotational position of the torque control with respect to the rod, and consequently maintains rotational positions of the track, the visor body and the second pivotal attachment with respect to the rod, said track allowing a longitudinal distance between the first and second pivotal attachments to vary with longitudinal movement of said visor body.”

Support for this change is provided in Figures 2, 3, 6, and 7 and the accompanying text beginning at column 2, line 49.

Dependent claims 17, 19-20 and 23-28 are dependent upon independent claim 16 and overcome the rejection under 35 U.S.C. § 112 due to individual amended changes and the amended changes to claim 16. Please note that claims 18 and 21-22 have been cancelled and claims 23 and 25 have been amended to reflect the cancellation of claim 22.

Claim 30 has been cancelled by this paper, however claim 31 has been amended to avoid vagueness due to a negative limitation. Support for this change is provided in Figures 2, 3, 6, and 7 and the accompanying text beginning at column 2, line 49.

Accordingly, Applicants respectively assert that claims 3, 7, 9, 11, 13-14, 16-17, 19-20, 23-28 and 31 have been amended to overcome the rejection under 35 U.S.C. § 112.

Recapture

6. Claims 5-31 have been rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. However, the claims have been amended by this paper, thus narrowing the scope to subject matter that was not surrendered in the application for the issued patent.

“Under [the recapture] rule, claims that are ‘broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution’ are impermissible.” *Hester Industries, Inc. v. Stein Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641 (Fed. Cir. 1998), quoting *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997); quoting *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). “Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims.” *Id.* 142 F.3d at 1480. “Reissue claims that are broader in certain respects and narrow in others may avoid the effect of the recapture rule.” *Id.* 142 F.3d at 1482, 46 USPQ2d 1641, quoting *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. *Clement* set forth the test:

“(1) if the reissue claim is as broad or broader than the cancelled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an

aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.”

131 F.3d at 1470.

The reissue claims now presented do not impermissibly recapture surrendered subject matter. Each reissue claim is narrower than the claims cancelled or amended in the original application with regards to the guide – an aspect germane to the prior art rejection. Accordingly, under (2) and (3)(b) of the *Clement* test, the recapture rule does not apply irrespective of whether the claims are broader or narrower in any other aspect.

The reissue claims are narrower than the original claims with respect to the guide. Original claim 1 included “a guide being fixed to . . . said torque control” and was rejected. Then claim 1 was amended to include “a guide extending between said torque control and said track.” Claim 1 was rejected again. Issued claim 1 combined amended claim 1 and dependent claim 2 to include “said guide having a substantially H-shaped cross section.” Claims 3 and 4 were dependent from original claim 1 and were rewritten as independent claims to overcome the rejection of original claim 1. As such, the structure of the guide was an aspect pertinent to the prior art rejection of the original application.

Reissue claims 5-17, 19-20, and 23-29 claim includes “a guide fixed [] to said torque control . . . having a pair of opposing legs.” (Claims 5, 16, 29.) Each reissue claim is narrower with regards to this aspect than original claim 1 that recited “a guide being fixed to one surface of said torque control.” Thus, reissue claims 5-29 are “narrower in an aspect germane to prior art rejection.” According to (2) of *Clement*, if the remaining aspects are narrower, recapture does not apply. According to (3) of *Clement*, if the remaining aspects are broader, recapture does not apply. Therefore, since the reissue claims are “narrower in an aspect germane to prior art rejection,” recapture does not apply. *Clement*, 131 F.3d at 1470.

Reissue claims 18, 21, 22, and 30 have been cancelled.

Reissue claim 31 is broader than original claim 1 in many aspects. However, reissue claim 31 is narrower than original claim 1 regarding the structural limitations of the first member. In original claim 1, there were no structural limitations of the guide. Thus, by including the following language in Claim 31, the reissue claim is narrower than original claim 1: "first member pivotally attached to said rod in a non-slidable manner and including a pair of opposing legs extending therefrom." Accordingly, although broader in other aspects, claim 31 does not impermissibly recapture surrendered subject matter, because it is narrower with regards to an aspect germane to the prior art rejection of the original application.

Applicants respectively request that the Examiner's rejection under 35 U.S.C. § 251 of reissue claims 5-17, 19-20, 23-29 and 31 be withdrawn for reasons listed above.

Claim Rejections Under 35 U.S.C. § 102

7,8. The Examiner has rejected claim 4 under 35 U.S.C. § 102(e) as being anticipated by Crotty, III, U.S. Patent No. 5,823,603. Applicants respectfully argue that this rejection is improper. In order to anticipate a claim, the reference must disclose every element and limitation of the claim. The Crotty '603 reference fails to disclose "a visor body" as set forth in claim 4. Examiner cited as a visory body 36 which does not disclose: (1) "a longitudinally extending bore for receiving said rod," (2) "a longitudinally extending track," (3) "said track forming a substantially enclosed longitudinally extending passage . . . being shaped to receive a portion of the guide in a sliding engagement," (4) "said track slides relative to said guide," (5) "said second leg [of said guide] is received within said passage and said cross bar extends through a slot formed in said track." Further, the Crotty '603 reference fails to disclose "a guide fixed to one surface of said torque control" having "a first leg," "a second leg," and "a cross bar joining said first leg to said second leg." Nor does Crotty disclose a visor body having "a passage being shaped to receive a portion of said guide in sliding

engagement” where the “guide . . . is fixed to one surface of the torque control.” Assuming arguendo that a portion of the guide is 106 as the Examiner suggests, 106 is not “fixed to one surface of the torque control.” Claim 4 fails to read on the Crotty ‘603 reference and therefore the Crotty ‘603 reference fails to anticipate claim 4. Accordingly, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(e) rejection of claim 4.

9,10. The Examiner has rejected claims 5-8, 12, 15-19, 21, 26-27, and 30 under 35 U.S.C. § 102(b) in view of Snyder et al., U.S. Patent No. 5,409,285. Claim 5 has been amended to include the limitation that the guide has “a pair of opposing legs” and the track is shaped to cooperate “within the pair of opposing legs”. Support for this change is provided in Figure 3 and the accompanying text at column 3, lines 57-67, and at column 4, line 59 to column 5, line 6. The Snyder ‘285 reference does not disclose a guide having a pair of opposing legs and therefore the amended claim 5 overcomes this rejection. Accordingly, claims 6-8, 12 and 15 overcome this rejection as being dependent upon claim 5.

Claim 16 has also been amended to include “a guide” “having a pair of opposing legs”. Support for this change is provided in Figure 3 and the accompanying text at column 3, lines 57-67, and at column 4, line 59 to column 5, line 6. The Snyder ‘285 reference does not disclose a guide having opposing legs and therefore the amended claim 16 overcomes this rejection. Further, claims 17, 19, and 26-27 overcome this rejection as being dependent upon claim 16.

Claims 18, 21, and 30 have been cancelled by this paper.

11. The Examiner has rejected claims 5-8 and 30 under 35 U.S.C. § 102(b) as being anticipated by Abu-Shumays et al. U.S. Patent No. 5,044,687. Claim 5 has been amended so that the guide includes “a pair of opposing legs” such that the track cooperates “within the pair of opposing legs”. Support for this change is provided in Figure 3 and the accompanying text at column 3, lines 57-67, and at column 4, line 59 to column 5, line 6. The Abu-Shumays et

al. '687 reference fails to disclose such a limitation and therefore the amended claim 5 overcomes this rejection. Accordingly, claims 6-8 being dependent upon claim 5, overcome this rejection as well.

Claim 30 has been cancelled by this paper.

12. The Examiner has rejected claim 29 Under 35 U.S.C. § 102(b) as being anticipated by Clark U.S. Patent No. 4,925,233. The Clark '233 reference discloses a pair of downwardly depending legs 54, 56 for providing the torque control about the pivot rod 30, rather than acting as a guide. In fact, legs 54, 56 do not even engage channel 90. Regardless, claim 29 has been amended such that the longitudinally extending track is slidably "engaged between" opposing legs of the guide, in stark contrast to anything disclosed in the Clark '233 reference. Therefore, the Clark '233 reference fails to anticipate claim 29. Support for this change is provided in Figure 3 and the accompanying text at column 3, lines 57-67, and at column 4, line 59 to column 5, line 6.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw all anticipation rejections.

Information Disclosure Statement

13. A supplemental information disclosure statement was filed on February 18, 2003. The supplemental information disclosure statement includes U.S. Patent No. 4,734,955 issued to Connor on April 5, 1988. Although this reference was submitted with the prior information disclosure statement, the patent number was incorrectly typed on that statement.

The supplemental information disclosure statement filed on February 18, 2003 also includes a resubmittal of all the foreign patent documents filed with the previous information disclosure statement. The foreign patent documents filed on February 18, 2003 also include a concise explanation of the relevance, as is presently understood by the individual designated in 37 C.F.R. § 1.56(c) most knowledgeable about the content of the information, of each patent listed is not in the English. This concise explanation is represented by English abstracts of these reference patent documents. No English abstracts are provided by the Applicants for foreign patent documents GB 2 088 299; GB 2 115 762; and GB 2 154 192 because these references include English abstracts incorporated within the individual documents.

Specification

14. No correction has been made to Claim 11 in regards to the ridge, because the ridge is supported within the specification. See ridge 104, column 4, lines 35-36. Claims 8-11 are amended by this paper to replace the word "rail" with the word "wall", which has proper antecedent basis. Claim 14 has been amended to remove the language regarding "contacting an elbow".

In light of the foregoing, Applicants respectfully assert that the Examiner withdraw objections to the specifications.

Conclusion

Applicants respectfully assert that the application is in condition for allowance, which allowance is hereby requested.

Please charge any fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

JAY A. MURDOCK ET AL.

By 

Michael D. Turner

Reg. No. 52,306

Attorney for Applicants

Date: *06/24/03*

BROOKS & KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351